

SECTION III—REMARKS

This Amendment is submitted together with an RCE in response to the Advisory Action mailed January 23, 2004. Claims 1 and 19 are amended herein, and new claims 27-28 are added. Claims 1, 3-5, 7, 8, 19, and 21-38 remain pending in the application. Applicant respectfully requests reconsideration of the application and allowance of all pending claims in view of the following remarks.

Information Disclosure Statement

Applicant submitted an Information Disclosure Statement (IDS) together with the response to the final Office Action. The Examiner has provided no acknowledgement that the IDS was received and that the references cited on the accompanying form PTO-1449 were considered. Applicant respectfully requests that the Examiner consider the references cited in the IDS and return an initialed copy of the PTO-1449 with the next office action.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1, 3-5, 19, and 21-24 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent No. 5,704,650 to Laurash et al ("Laurash"), U.S. Patent No. 6,536,660 to Blankenship et al ("Blankenship") and one or both of U.S. Patent Nos. 5,783,810 and 5,793,030 to Kelly, Jr. (collectively "Kelly"). The Examiner also rejected claims 7, 8, 25 and 26 under § 103(a) as obvious in view of, and therefore unpatentable over, Laurash, Kelly and Blankenship further in view of U.S. Patent No. 6,348,685 to Brower et al ("Brower").

Applicant respectfully traverses the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, the Examiner has not established a *prima facie* case of obviousness.

Claim 1, as amended, recites an article of manufacture comprising a component container and "first and second labels removably affixed to the component container, each label having printed thereon an identifier that uniquely identifies a component inside the component container, the identifier being electronically stored in the component, and the identifier being read from the component and printed on the labels." The Examiner conceded in the final Office

Action that Laurash and Kelly do not disclose an identifier electronically stored in the component and read therefrom and printed on labels, and conceded in the Advisory Action that Blankenship also does not disclose this limitation. The Examiner, however, now asserts that this limitation is nothing but a statement of the intended use (read for printing on labels) that does not result in a structural difference between the claimed invention and the prior art, and if the prior art is capable of performing the intended use, then it meets the claims.

Applicant respectfully disagrees. What the Examiner has identified as a statement of intended use is nothing of the sort: a statement of intended use is a recitation with respect to the manner in which the claimed apparatus is intended to be used. MPEP § 2114. Here, the limitation in question says nothing regarding the use of the claimed article, nor even of the use of the particular element it limits. Rather, it is simply a limitation regarding the source of the information on the labels. It is therefore not a statement of intended use. It is also not a functional limitation: a functional limitation defines something by what it *does* instead of what it *is*. MPEP § 2173.05(g). This limitation says nothing regarding what the label or the information printed thereon *does* but, as explained above, it is simply a limitation regarding the source of the information on the labels. Since the recited limitation is therefore not a statement of use or a functional limitation, and in view of the Examiner's concession that such a limitation is not found in the prior art, Applicants respectfully request withdrawal of the rejection and allowance of the claim.

Regarding claims 3-5, 7 and 8, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant therefore respectfully submits that claims 3-5, 7 and 8 are allowable by virtue of their dependence on allowable claim 1 and by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 19 recites an article of manufacture comprising a base label having a designated area thereon to receive an identification label, and "first and second identification labels removably attached to the designated area of the base label, each identification label having printed thereon an identifier that uniquely identifies a component inside a component container to which the base label can be attached, the identifier being electronically stored in the component, and the identifier being read from the component and printed on the identification

labels.” For the reasons discussed above in connection with claim 1, Applicant submits that Laurash, Blankenship and Kelly cannot render the claimed invention obvious, and therefore respectfully requests withdrawal of the rejection.

Regarding claims 20-26, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 19 is in condition for allowance. Applicant therefore respectfully submits that claims 20-26 are allowable by virtue of their dependence on allowable claim 19 and by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

New claim 27 recites an article of manufacturing comprising a component container and “first and second labels removably affixed to the component container, each label having printed thereon an Media Access Control (MAC) number that uniquely identifies a network interface card inside the component container, the MAC number being electronically stored in the network interface card, and the MAC number being read from the network interface card and printed on the labels.” Laurash, Kelly and Blankenship do not disclose, teach or suggest a combination including the claimed limitations. Applicant submits that new claim 33 is therefore in condition for allowance.

Regarding new claims 28-32, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 27 is in condition for allowance. Applicant therefore respectfully submits that claims 28-32 are allowable by virtue of their dependence on allowable claim 28, as well as by virtue of the features recited therein. Applicant therefore respectfully requests allowance of these claims.

New claim 33 recites an article of manufacture comprising a base label having a designated area thereon to receive an identification label and “first and second identification labels removably attached to the designated area of the base label, each identification label having printed thereon a Media Access Control (MAC) number that uniquely identifies a network interface card inside a component container to which the base label can be attached, the MAC number being electronically stored in the network interface card, and the MAC number being read from the network interface card and printed on the identification labels.” As discussed above in connection with new claim 27, Laurash, Kelly and Blankenship do not

disclose, teach or suggest a combination including the claimed limitations. Applicant submits that new claim 33 is therefore in condition for allowance.

Regarding new claims 34-38, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 33 is in condition for allowance. Applicant therefore respectfully submits that claims 34-38 are allowable by virtue of their dependence on allowable claim 33, as well as by virtue of the features recited therein. Applicant therefore respectfully requests allowance of these claims.

Conclusion

Given the above remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.


Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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